

## **REMARKS**

Applicants appreciate the courtesy extended to the undersigned by Examiner Fenstermacher during a phone conference just after Examiner Fenstermacher was assigned to this case. During said phone conversation, Examiner Fenstermacher noted that he was newly assigned to the application; that he noticed that the previous Examiner had issued a final rejection; applicants appealed; applicants prepared and filed an appeal brief; and the prior Examiner, instead of responding to the appeal with a brief, withdrew the finality of the prior rejection but otherwise maintained essentially the same grounds of rejection.

Applicants respectfully submit that amendments made herein put this case in condition for allowance, and that the grounds for rejection in the January 26, 2005 Official Action were insufficient in any event without these amendments.

Support for the amendments made herein is found in the drawings and the specification as described hereafter.

The prior Examiner<sup>1</sup> rejected claim 16 under 35 U.S.C. Section 112, and claims 14, 16 and 17 under 35 U.S.C. Section 103(a) in view of previously discussed patents to Bathrick and Willis. In substance, the prior Examiner repeated in the January 26, 2005 Official Action the rejections made in an April 30, 2004 Official Action, before Applicants incurred the significant expense and time of having an extensive appellate brief researched and prepared. Applicants' brief was apparently persuasive enough for the prior Examiner to withdraw the prior final rejection and attempt to address many of the shortcomings of his prior

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<sup>1</sup> Prior Examiner Timothy P. McAnulty apparently left the Patent and Trademark Office to attend law school within days after signing the January 26, 2005 Official Action. Examiner Fenstermacher was thereafter assigned to be in charge of this application.

rejections. Applicants respectfully submit that despite this effort, there never was a basis for the rejections and that in view of the amendments herein there is no reason to maintain any of these rejections. Allowance is respectfully solicited.

On July 30, 2004, Applicants submitted a proposed amendment under 37 C.F.R. § 1.312 in response to the April 30, 2004 final rejection by Examiner McNulty. The proposed amendment included some changes to the claims, but prior Examiner McNulty refused to enter the amendment. Since prior Examiner McNulty has now withdrawn the finality of the last rejection, Applicants hereby submit amendments to the claims.

Applicants have clarified that the claims are directed to motion furniture that is considered "seating furniture." These claims are directed to an embodiment of this invention most clearly understood with reference to Figures 10 through 12, and paragraphs 41 through 43 of the application. This embodiment, however, has elements of its structure described earlier in the specification as corresponding with the other embodiments found in the specification.

The person of ordinary skill in this art will readily recognize that seating furniture embraces chairs, and other similar structures (such as love seats, couches and sofas). Love seats, couches and sofas are readily known to be types of seating furniture. In effect, these items are merely wide chairs. It is apparent that by referring to seating furniture that the Applicants mean a structure used for seating in the ordinary case. Figures 10 through 12 show a clear example.

The claims are not directed to articulating hospital beds as shown in U.S. Patent No. 5,568,661 to Bathrick, et al. ("Bathrick") and U.S. Patent No. 5,072,463, to Willis ("Willis"), the two references cited by the prior Examiner in the January 26, 2005 Official Action. Neither Bathrick nor Willis relate to seating furniture as those skilled in the art understand that term. The person of ordinary skill in the furniture art readily knows the difference. In fact, laymen know the difference between seating furniture and hospital-type beds.

Moreover, Applicants have further clarified that the pantographic style linkage is positioned between the footrest and a portion of a frame of the seating furniture, and facilitates movement of the footrest between a vertical stowed position that is generally perpendicular to the seat portion of the furniture, and a fully extended position that is generally parallel to the seat portion, as well as intermediate positions. Bathrick does not disclose pantographic style linkage, and Willis does not disclose a footrest moving from a vertical stowed position to a horizontal, fully extended position for a person sitting in seating furniture (i.e., the footrest moves 90 degrees "upward" from the stowed position).

One of ordinary skill in the art finds support for these amendments throughout the specification, including without limitation in Figures 10 through 12, and Figure 3, and in paragraphs 26 through 28 and 41 through 43 of the application. Neither Bathrick nor Willis, the cited references, teach or even suggest seating furniture with the capability of the aforementioned positioning and the 90° range of movements of the legs of a person when otherwise sitting stationary on the seating furniture.

In the January 26, 2005 Official Action, prior Examiner McNulty rejected claims 14, 16 and 17 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Bathrick in view of Willis patent. In their appellate brief, and in previous filings with the prior Examiner, Applicants have also made it clear that the prior Examiner has never made a proper *prima facie* case of obviousness, failing on several grounds, most notably the lack of the elements claimed and an absence of specific evidence of a motivation to combine those elements found in Bathrick and Willis. In view of the amendments herein, not only are the Bathrick and Willis references not inclusive of all of the currently claimed features, but even if they did have such features (which they don't), there is still no motivation to combine these references.

For example, the prior Examiner's contention that "any judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning" is directly contrary to the law and the M.P.E.P. See In re Lee, 277 F.3d 1338 (Fed. Cir. 2002); M.P.E.P. § 2142 ("To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made."). The prior Examiner makes the contention that "the *mere fact* that the structure of Willis, namely the pantograph linkage system, may not be easily bodily incorporated into the structure of Bathrick, does not negate a *prima facie* case of obviousness." (Emphasis added). This is simply untrue as a matter of fact and law. The structure of Willis cited by Examiner McNulty cannot be applied to Bathrick at

all, “bodily” or otherwise. The fact that the structure that the Examiner seeks to combine from one reference cannot physically be combined with a second reference, and therefore would produce an inoperative device, is strong evidence of a teaching away from a person of ordinary skill making the combination, and therefore constitutes strong evidence of non obviousness, as discussed below.

The Federal Circuit, in *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339 (Fed. Cir. 2001), has stated that when prior art references can be shown to teach away from a combination, the claimed invention is typically unobvious. The Federal Circuit held:

Perhaps *McGinley*’s best argument to save his claims from prima facie obviousness in the light of *Pratt* and *Morgan* is his contention that those references together teach away from their combination. We have noted elsewhere, as a “useful general rule,” that references that teach away cannot serve to create a prima facie case of obviousness. *In re Gurley*, 27 F.3d 551, 553, 31 U.S.P.Q.2d (BNA) 1130, 1132 (Fed. Cir. 1994). If references taken in combination would produce a ‘seemingly inoperative device,’ we have held that such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness. *In re Spinnoble*, 56 C.C.P.A. 823, 405 F.2d 578, 587, 160 U.S.P.Q. (BNA) 237, 244 (CCPA 1969) (references teach away from combination if combination produces seemingly inoperative device); see also, *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984) (inoperable modification teaches away).

*McGinley*, 262 F.3d at 1353-54.

The meaning of the concept of “teaching away” was also explained in the case of *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). According to the Federal Circuit, “a reference may be said to teach away when a person of ordinary skill,

upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. The degree of teaching away will of course depend upon the particular facts; in general, a reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the results sought by the applicant." *In re Gurley*, 27 F.3d at 553. Thus, contrary to the prior Examiner's contention, the fact that the alleged analog to the pantographic style linkage in Willis cannot be modified to attach to the structure of Bathrick, and that the rigid attachment of such structure in Willis contravenes a primary object of Bathrick – ease of modular disassembly – is strong evidence of non-obviousness. The Examiner essentially admits to the inability to combine these structures when he acknowledges that the pantographic style linkage cannot be bodily incorporated into the structure of Bathrick. As a result, claims 14, 16 and 17 are not obvious in view of Bathrick and Willis combined.

With respect to the rejection of claim 16 under Section 112, Applicants have clarified the claim with regard to the connection, and believe they have addressed prior Examiner McAnulty's concerns.

## **CONCLUSION**

For all of the foregoing reasons, Applicants respectfully request that the amendments be entered herein. Applicants further submit, as amended, the claims are in condition for allowance. Alternatively, Applicants respectfully

submit that the grounds for rejection set forth by the prior Examiner do not meet his burden for a proper rejection under 35 U.S.C. § 103, and on this ground Applicants also respectfully request that claims 14, 16 and 17 be allowed.

Respectfully submitted,

A handwritten signature in black ink, reading "Leland P. Schermer". The signature is written in a cursive style with a large, stylized initial "L".

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